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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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JAMES C. WRAY
1493 CHAIN BRIDGE ROAD
SUITE 300
MCLEAN VA 22101

IM51/0717

EXAMINER

DUSHECK, C

ART UNIT

PAPER NUMBER

1751

DATE MAILED: 07/17/98

Please find below and/or attached an Office communication concerning this application or
proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
08/865,419

Applicant(s)
Auger

Examiner
Caroline D. Liott

Group Art Unit
1751



☒ Responsive to communication(s) filed on Jun 1, 1998

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-36 is/are pending in the application.

Of the above, claim(s) 2-29 is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1 and 30-36 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 4

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Art Unit: 1751

Applicant's Response filed 6/1/98 has been entered. Examiner agrees that claims 31-36 were erroneously omitted from Group I.

Applicant's election with traverse of Group I, claims 1 and 30-36 in Paper No. 11 is acknowledged. The traversal is on the ground(s) that Groups II and III are examined in the same class and subclass. Because two groups of claims are examined in the same class and subclass does not render the claims non-restrictable. The claimed kits and methods are properly restrictable for the reasons set forth in Paper #10. Furthermore, the classes and subclasses recited in the restriction are followed by a plus sign. This is because the entire field of search for these two groups is not listed, and is different. For Example, the claimed methods would require a search in class 427, while the claimed products would not. Furthermore, the actual class and subclass wherein each set of claims is classified ultimately depends upon the substrate treated.

Applicant argues that the process as claimed cannot be practiced by a materially different apparatus, and that the apparatus as claimed cannot be used to practice another and materially different process. Applicant also argues that the process as claimed cannot be used to make another and materially different product, and that the product as claimed cannot be made by another and materially different process. Applicant further argues that the apparatus as claimed cannot be used for making a different product, and the product as claimed cannot be made by a materially different apparatus. Process and apparatus claims, process and product claims, and apparatus and product claims only require one-way distinctness to be properly restrictable. However, two-way distinctness was clearly explained in Paper #10 for each Group of claims.

Art Unit: 1751

Particularly, the apparatus as claimed can be used to practice another and materially different process such as a process of cleaning or disinfecting a hard surface, and the process as claimed can be practiced with another materially different apparatus such as with a kit which contains a dyeing compound such as an azo dye. The process as claimed can be used to make a materially different product such as a disinfected hard surface, and the product as claimed can be made by a materially different process such as by a process of contacting the product with a dye composition which contains a dye compound such as an azo dye. The apparatus as claimed can be used for making a different product such as a disinfected hard surface, and the product as claimed can be made by a materially different apparatus such as by a kit which contains a dyeing compound such as an azo dye. Applicant has not disputed or explained how these provided examples do not prove the one-way distinctness required for restriction. Therefore, these arguments are not deemed persuasive.

Applicant argues that claim 2 is substantially the same scope as claim 30, and same with the dependent claims. Examiner respectfully disagrees because claim 30 does not require any step of contacting a substrate as required by claim 2.

Applicant argues that claim 23 is a linking claim which requires a method of claim 2, and therefore concludes that the claims of Groups II and III cannot be separated. Examiner agrees that claim 23 is a linking claim; however, this does not mean that Groups II and III are not restrictable. See MPEP 809.

The requirement is still deemed proper and is therefore made FINAL.

Art Unit: 1751

This application contains claims 2-29 drawn to an invention nonelected with traverse in Paper No. 11. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

The previous election requirement has been withdrawn because Applicant's elected invention, Group I, does not recite any specific substrates to be treated with the claimed kits, i.e. there are no Markush claims or species claims in Group I (with regard to the substrate). Furthermore, the intended use of the claimed kits is given little, if any, patentable weight. See *In re Albertson*, 141 USPQ 730 (CCPA 1964); *In re Heck*, 114 USPQ 161 (CCPA 1957), and *Ex parte Wikdhal*, 10 USPQ 2d 1546, 1548 (BPAI 1989).

Claims 1 and 30-36 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1 and 30 are indefinite because the terms "mineral salt," "peroxide," and "oxygen source" are defined so broadly that they read upon one another. For example, the specification teaches that both the claimed metal salts and the claimed peroxides or oxygen sources include zinc peroxide, see page 6, lines 16-17 and 21. A claim is indefinite when one component is defined so broadly that it reads upon another component. Furthermore, this causes confusion as to whether or not the solutions of metal salt and peroxide may be the same (which would be interpreted as a kit with a single solution). Clarification is required.

Art Unit: 1751

Claim 31 is also indefinite for listing several components in the Markush group more than once. For Example, the Markush group includes a coloring agent, a pigment, a dye, a tint, and a color. What is the difference between a coloring agent, a tint and a color? The claim also recites a "salt" and a "bleach;" however, the claim from which it depends already requires metal salts and peroxygen sources (i.e. bleaches). The claim also lists the "alcohol" species twice. Clarification of these additives is required.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 30-34 and 36 are rejected under 35 U.S.C. 102(b) as being anticipated by Dombay.

Dombay, U.S. Patent No. 3,554,785, teaches and exemplifies a process for treating wood (teak) with a kit as claimed in order to obtain a color on the wood, see Example 4. Specifically, the "kit" comprises a solution A which contains the metal salt cupric sulfate in the claimed

Art Unit: 1751

amounts, as well as an acid (hydrochloric) as claimed, see Example 4. This composition is diluted with water and is first applied to the wood. The wood is then treated with a second aqueous solution which contains hydrogen peroxide in the claimed amounts, see Example 4 and col. 3, lines 19-25. Dombay teaches that this solution is also suitable for dilution as claimed, see col. 5, lines 56-64. Dombay, therefore, clearly anticipates wood treating and coloring kits as claimed.

Claims 1 and 30-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dombay.

Dombay is relied upon as set forth above as teaching and exemplifying wood coloring kits which comprise an aqueous solution of a metal salt, and an aqueous solution of hydrogen peroxide as claimed. Dombay teaches that the peroxide oxidant may be present in the lower claimed proportions (see col. 4, lines 35-38), but does not exemplify a kit which contains the peroxide in such proportions.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to formulate a kit which comprises a first composition which contains water and a metal salt in the claimed amounts, and a second composition which contains water and hydrogen peroxide in the claimed amounts, wherein each composition is sequentially applied to wood to color the wood, because such kits fall within the scope of those as taught by Dombay.

Claims 1, 30 and 32-33 are rejected under 35 U.S.C. 102(b) as being anticipated by Zemans.

Art Unit: 1751

Zemans, U.S. Patent No. 4,144,089, teaches a method for bleaching wood wherein the wood is first treated with a basic solution, followed by treatment with hydrogen peroxide, see claim 1. The patentee exemplifies the use of a 10% sodium carbonate (basic metal salt) solution and a 50% hydrogen peroxide solution, see col. 2, line 44-col. 3, line 8. Zemans, therefore, clearly anticipates kits which comprise solutions of metal salts and hydrogen peroxide in the claimed amounts.

Claims 1 and 30-34 are rejected under 35 U.S.C. 102(b) as being anticipated by Gentile.

Gentile Jr., U.S. Patent No. 4,849,053, teaches and exemplifies two and three part compositions for treating wood chips wherein one of the parts comprises an aqueous solution of metal salt (e.g. Epsom salt) in the claimed amounts, and another part comprises an aqueous solution of hydrogen peroxide in the claimed amounts, see Examples 1-6. Note that the compositions also contain additives as claimed (e.g. acids and salts). Gentile, therefore, clearly anticipates kits which comprise aqueous solutions of metal salts and hydrogen peroxide in the claimed amounts.

Claims 1 and 30-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gentile.

Gentile is relied upon as set forth above as teaching and exemplifying compositions which contain the claimed "kits" which comprise a first aqueous composition which contains a metal salt in the claimed amounts, and a second aqueous composition which contains hydrogen peroxide in the claimed amounts. Gentile teaches that the compositions which contain the peroxide may

Art Unit: 1751

contain from 10-100 grams/liter hydrogen peroxide, see col. 7, lines 48-55. Gentile does not exemplify the claimed lower peroxide proportions.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to formulate “kits” which comprise two compositions, the first of which contains water and a metal salt in the claimed amounts, and the second of which contains water and hydrogen peroxide in the claimed amounts, because such two-part “kits” or compositions are taught by Gentile.

Claims 1 and 30-35 are rejected under 35 U.S.C. 102(b) as being anticipated by Brown.

Brown, U.S. Patent No. 5,173,085, teaches and exemplifies three-part compositions for dyeing hair wherein the first part comprises an aqueous solution which contains additives (e.g. a surfactant) and a metal salt (e.g. copper sulfate) in the claimed amounts, and the third part comprises a 6% aqueous solution of hydrogen peroxide, see Examples 2-4. Brown, therefore, clearly anticipates the claimed kits which comprise aqueous metal salt and peroxide solutions.

Claims 1 and 30-35 are rejected under 35 U.S.C. 102(b) as anticipated by Hall.

Hall, U.S. Patent No. 3,632,295, teaches and exemplifies two-part compositions for bleaching hair or wool, wherein the first part contains a metal salt (e.g. ferrous ammonium sulfate) in the claimed amounts, water, and additives (e.g. acids), and the second part contains water and a peroxide in the claimed amounts, see Examples 1-5. Hall, therefore, clearly anticipates the claimed kits which comprise aqueous metal salt and peroxide solutions.

Art Unit: 1751

Claims 30-31 are rejected under 35 U.S.C. 102(b) as anticipated by Est. Light Ind. Min. (herein referred to as Light).

Light, SU 499,297 (see provided English language Abstract for all citations), teaches processes for treating leather by first tanning it with a solution of hydrogen peroxide (an oxygen source) and sodium hydroxide (a salt or base), followed by treating with aluminum salts (a metal salt). Light, therefore, clearly anticipates kits which comprise a peroxygen source and a metal salt preparation as claimed.

A translation of Light has been ordered.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Translations of Matsushita Electrical Works Ltd, JP 60-8008 and JP 60-250906, have been ordered.

Applicant is reminded that if any evidence is to be presented in accordance with 37 C.F.R. 1.131 or 1.132, such evidence should be presented before final rejection in order to be considered timely.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Caroline Liott whose telephone number is (703) 305-3703. The examiner can normally be reached on Mondays-Thursdays from 8:30am to 6:00pm, and on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paul Lieberman, can be reached on (703) 308-2523. All official before final faxes should be sent to (703)305-7718. All official after final faxes should be sent to (703)305-3599. All non-official faxes should be sent to (703)305-6078.

Serial Number: 08/865,419

Page 10

Art Unit: 1751

Any inquiry of a general nature should be directed to the Group receptionist whose telephone number is (703) 308-0661.

C.D.L. *CSZ*
July 14, 1998

A handwritten signature in cursive script, appearing to read "Paul Lieberman", with a long horizontal flourish extending to the right.

PAUL LIEBERMAN
SUPERVISORY PRIMARY EXAMINER
ART UNIT 115